

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: October 6, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Andre Maurice

Serial No. 86834686

Andre Maurice, pro se.

Laura D. Golden, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.¹

Before Kuhlke, Wolfson and Pologeorgis,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Andre Maurice (“Applicant”) seeks registration of the proposed mark FEYONCE
(in standard characters) on the Principal Register for various items of clothing² in

¹ The Office reassigned the present application from Trademark Examining Attorney Daniel Stringer to Laura D. Golden during prosecution of the application.

² “Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic shirts; Camouflage shirts; Camp shirts; Collared shirts; Dress shirts; Fishing shirts; Gift packages sold as a unit consisting primarily of a sweatshirt and also including a photo frame, a coffee mug, and a tote bag; Golf pants, shirts and skirts; Golf shirts; Graphic T-shirts; Henley shirts; Hooded sweat shirts; Hooded sweatshirts; Hunting shirts; Knit shirts; Long-sleeved shirts; Night shirts; Open-necked shirts; Over shirts; Pique shirts; Shirts; Shirts and short-sleeved shirts; Shirts and slips; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sleep shirts; Sport shirts; Sports shirts; Sports shirts with short sleeves;

International Class 25.³ The Trademark Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on two prior registrations, owned by the same entity, of the marks BEYONCE' and YONCÉ, both in standard characters.⁴ Both registrations include clothing items in International Class 25.⁵ With respect to the mark BEYONCE', the Examining Attorney based the refusal on those goods identified in International Class 25 only, namely, "Clothing, namely - shirts, sweaters, blouses, jackets, slacks, hats and caps." The YONCÉ registration is for "Clothing, namely, shirts, t-shirts, bottoms, shorts, tops, sweat shirts, pajamas, and sleepwear."

The Examining Attorney also refused registration of Applicant's FEYONCE mark under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051-52 and 1127, on the basis that the proposed mark fails to function as a trademark. Specifically, the Examining Attorney found that "evidence of numerous third parties using the same wording on their goods, as well as evidence of the wording being used on social media

Sweat shirts; Sweatshirts; T-shirts; Tee shirts; Wearable garments and clothing, namely, shirts; Women's clothing, namely, shirts, dresses, skirts, blouses; Woven shirts; Yoga shirts."

³ Application Serial No. 86834686 was filed on November 30, 2015 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based on Applicant's allegation of first use of the mark anywhere and in commerce on November 1, 2015.

⁴ Reg. No. 2879852 for the mark BEYONCE' issued on August 31, 2004; renewed. The registration includes the following consent statement, "The name 'BEYONCE' identifies a living individual whose consent is of record."

Reg. No. 5638150 for the mark YONCÉ issued on December 25, 2018. The registration includes the following consent statement, "The name 'YONCE' identifies a living individual whose consent is of record."

⁵ Reg. No. 2879852 also covers goods and services in International Classes 16 and 41, which are not at issue in this proceeding.

platforms to convey the message that someone is engaged to be married,” shows that the term has become a commonly used word that will not be perceived as a source indicator. 9 TTABVUE 5.⁶

When the refusals were made final, Applicant filed a Request for Reconsideration and appealed to this Board. Following denial of Applicant’s Request for Reconsideration, the appeal resumed and is fully briefed.

I. Preliminary Matter – Exhibits Attached to Applicant’s Brief

Applicant argues that the Office is biased against Applicant because “there was no registered mark with FEYONCE prior to Applicants [sic] application however, there is an application filed after Applicant’s which included the term FEYONCE. *See Exhibit D.* This application was filed on November 9, 2018 and was granted registration on August 6, 2019. *See Exhibit E.*” 7 TTABVUE 3.

Exhibit D (TESS printout) and Exhibit E (TSDR printout) were filed for the first time as attachments to Applicant’s brief. 9 TTABVUE 28-31. The Exhibits were properly objected to by the Examining Attorney as untimely, 9 TTABVUE 10. They have accordingly not been considered. 37 C.F.R. 2.142(d) (“Evidence should not be filed with the Board after the filing of a notice of appeal.”).

II. Likelihood of Confusion

In its brief, the only argument Applicant advances in support of its position that

⁶ Citations to the appeal record are to TTABVUE, the Board’s electronic database. Citations to the prosecution history for the application are to the TSDR (Trademark Status and Document Retrieval) database. *See, e.g.,* TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 1203.01 (2020).

there is no likelihood of confusion is that “the matter of likelihood of confusion has been settled in US Federal Court Southern District of New York *Knowles-Carter v. Andre Maurice, Feyonce Inc.*” 7 TTABVUE 3. In *Knowles-Carter v. Feyonce, Inc.*, 347 F.Supp.3d 217, 226 (SDNY 2018), a trademark infringement action, the court denied plaintiff’s motion for partial summary judgment and ordered the parties to meet and confer regarding settlement. Following the issuance of the court’s decision, plaintiff moved for voluntary dismissal of the action with prejudice.⁷

The district court decision has no bearing on the Board’s decision in this proceeding. There is no issue preclusion for three reasons. First, the USPTO was not a party to the prior action. As the Board explained in *In re FCA US LLC*, 126 USPQ2d 1214, 1218 (TTAB 2018):

The fact that the USPTO has cited the Registrant’s registration in refusing to register the applied-for mark, leading to this appeal, does not indicate that Registrant somehow represented the USPTO in the prior proceeding. The Federal Circuit has long held that a determination in district court litigation does not bind the USPTO in a later ex parte proceeding.

FCA US LLC, 126 USPQ2d at 1218 (citing *In re Trans Tex. Holdings Corp.*, 498 F.3d 1290, 83 USPQ2d 1835, 1840) (“Since the PTO was not a party to the district court litigation, issue preclusion does not apply.”).

Second, the issues raised in the district court case and in this appeal “are different, at least in part, and require, to some extent, different analyses that could result in

⁷ The decision and motion for dismissal were made of the record by Applicant for the first time as part of his August 23, 2019 Response. Applicant’s resubmission of duplicate copies of these documents with his Request for Reconsideration and Appeal Brief was unnecessary and a needless waste of Board resources.

different determinations.” *FCA US LLC*, 126 USPQ2d at 1219. The court relied on extrinsic evidence showing that Applicant sells clothing directed “to fiancé purchasers” with “the mark FEYONCE and certain phrases from Beyonce’s well known songs” associated with the goods. In the ex parte registration context, the Board is constrained to consider the goods as recited in the application. We do not look to extrinsic evidence of the manner of use of the applied-for mark, nor do we consider how the goods are marketed. “Evidence of actual marketplace usages that seeks to limit or alter the usages ... listed in the application and registration are not considered in assessing likelihood-of-confusion in the registration context.” *FCA US LLC*, 126 USPQ2d at 1217 (citing *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2054 (2015)).

Finally, we find there is no issue preclusion as a result of the denial of plaintiff’s summary judgment motion in *Knowles-Carter v. Feyonce, Inc.* because the court did not render a final judgment on the issue of likelihood of confusion.

We also find there is no claim preclusion despite the dismissal order, because the claims in the infringement lawsuit were different from those at issue in this proceeding. *See, e.g., Sharp Kabushiki Kaisha v. ThinkSharp, Inc.*, 448 F.3d 1368, 79 USPQ2d 1376, 1379 (Fed. Cir. 2006) (citing *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1312 (Fed. Cir. 2005) (judgment on the merits in a prior suit bars a second suit only where the second suit “involve[es] the same parties or their privies based on the same cause of action”); *Am. Hygienic Labs., Inc. v. Tiffany & Co.*, 228 USPQ 855, 857 (TTAB 1986) (“[A] claim of

infringement before the court and a claim of priority and likelihood of confusion before this Board are different claims. The former claim is, in essence, a claim of injury resulting from applicant's use of its mark in commerce; the latter claim, in essence, is a claim that opposer believes it would be damaged by registration of applicant's mark.”).

We now turn to the refusal of registration under Trademark Act Section 2(d). Our determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We consider the *DuPont* factors for which there is evidence of record and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Two key considerations are the similarities between the marks and the relatedness of the goods and services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. Relatedness of the Goods; Channels of Trade; Classes of Consumers

The second and third *DuPont* factors consider the nature of the involved goods, their trade channels, and classes of consumers. *DuPont*, 177 USPQ at 567. We

consider the goods as they are identified in Applicant's and Registrant's application and cited registrations. *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). Here, both cited registrations and Applicant's application include "shirts." The goods are thus identical in part. We need not consider the similarity of the other identified goods because registration may be refused as to an entire class in the application if likelihood of confusion exists as to any item in that class. *See, e.g., Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, *6 (TTAB 2019) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA (1981)).

Furthermore, because the goods are identical in part, and neither Applicant's nor Registrant's identifications of goods contain any limitations on the channels of trade or classes of purchasers, we must presume that the channels of trade and classes of purchasers are the same. *See Stone Lion*, 110 USPQ2d at 1161; *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where goods are identical, the channels of trade and classes of purchasers are considered to be the same); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). And although Applicant argued during prosecution that its goods are "in the field of marriage and engagement," September 19, 2016 Response, TSDR 4, "an application with no restriction on trade channels cannot be narrowed by testimony

that the applicant's use is, in fact, restricted to a particular class of purchasers." *Stone Lion*, 110 USPQ2d at 1162 (internal citations omitted).

The identity of Applicant's and Registrant's goods and their overlapping channels of trade not only weigh in favor of finding a likelihood of confusion, but also reduce the degree of similarity of the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

The second and third *DuPont* factors favor a finding of likelihood of confusion.

B. Similarity of the Marks

We next compare Applicant's mark FEYONCE with Registrant's marks YONCÉ and BEYONCE' "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). (quoting *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *Inn at St. John's*, 126 USPQ2d at 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (citing

Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012)).

The marks are alike in appearance and pronunciation due to their shared letters “YONCE.” Registrant’s mark YONCÉ is incorporated within Applicant’s mark virtually in its entirety,⁸ and may be perceived as a shortened version of Applicant’s mark FEYONCE. Likelihood of confusion has frequently been found where one mark incorporates the entirety of another mark. *See Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL for gin and BENGAL LANCER for nonalcoholic club soda, quinine water and ginger ale); *Johnson Publ’g Co. v. Int’l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re S. Bend Toy Mfg. Co., Inc.*, 218 USPQ 479, 480 (TTAB 1983) (LIL’ LADY BUG for toy doll carriages and LITTLE LADY for doll clothing); *Helga, Inc. v. Helga Howie, Inc.*, 182 USPQ 629 (TTAB 1974) (junior party’s mark HELGA so resembles the senior party’s mark HELGA HOWIE as to be likely to cause confusion).

As for the mark BEYONCE’, the variance between this cited mark and Applicant’s mark FEYONCE consists of the single first letter “b” or “f,” as well as the ending apostrophe in BEYONCE’. The apostrophe is hardly noticeable and does not change the commercial impression of the mark. *See, e.g., Sw. Mgmt., Inc. v. Ocinomled, Ltd.*,

⁸ The presence of the accent mark over the letter “e” in YONCÉ does not obviate the likelihood of confusion between it and Applicant’s mark. Even if purchasers were to notice the accent over the letter “e” in the mark, they would likely pronounce FEYONCE the same way.

115 USPQ2d 1007, 1025 (TTAB 2015) (“No meaningful distinction arises from the possessive form of Applicant’s mark.”); *Winn’s Stores, Inc. v. Hi-Lo, Inc.*, 203 USPQ 140, 143 (TTAB 1979) (“[L]ittle if any trademark significance can be attributed to the apostrophe and the letter ‘s’ in opposer’s mark.”).

The fact that the marks employ different first letters likewise does not meaningfully distinguish them by sight or sound. The two terms look and sound alike due to the shared remainder of each mark, and the sounds “bey” and “fey” (the initial syllable of each) are not significantly different. Although Applicant’s argument that his mark will be pronounced “fiacé” rather than “fey-on-cé” is plausible, we are mindful that “there is no single ‘correct’ pronunciation of a trademark that is not a common English word because it is impossible to predict how the public will pronounce a particular mark.” *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1401-02 (TTAB 2010) (expert testimony of a linguist as to the correct pronunciation of the mark VIGILANZ (opposed by VIGILANCE) had “little probative value”) (citing *Centraz Indus. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (finding ISHINE likely to be confused with ICE SHINE, both for floor-finishing preparations)); see also *StonCor Group, Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649 (Fed. Cir. 2014).

As to the meaning of the two marks, taken on its face, the term FEYONCE is a fanciful term without specific meaning. Applicant may not always use his mark on goods that are “marriage-themed” and thus consumers may not always be inclined, as Applicant contends, to view the term as the equivalent of “fiacé.” The mark also

alludes to the popular singer Beyoncé, and the registrations for the marks BEYONCE' and YONCE state that they identify "a living individual." Consumers who recognize the allusion to Beyoncé are likely to believe that her company (the owner of the registered marks BEYONCE' and YONCE) has sponsored, or is affiliated with, Applicant. "Section 2(d) of the Trademark Act protects not only against confusion as to source, but also as to affiliation, connection or sponsorship." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1701 (TTAB 2001) (citing J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:8 (4th ed. 2000); *see also Majestic Distilling Co.*, 65 USPQ2d at 1205 ("...mistaken belief that [a good] is manufactured or sponsored by the same entity ... is precisely the mistake that Section 2(d) of the Lanham Act seeks to prevent"); *Hilson Research Inc. v. Society for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993). The marks are thus similar in connotation and commercial impression.

For the reasons discussed above, the first *DuPont* factor, the similarity or dissimilarity of the marks, also favors a finding of likelihood of confusion.

C. Balancing the Factors

The marks are substantially similar and will be used on identical goods that will travel through the same trade channels to the same classes of purchasers. Despite the possibility that Applicant's mark could be pronounced as "fiacé," the mark just as plausibly could be pronounced as "fey-on-cé," and be perceived as a direct play on the name of the popular singer Beyoncé. Thus, there is a likelihood of confusion not

only as to source, but as to sponsorship or affiliation with respect to Applicant's goods bearing the mark FEYONCE.

Decision: The refusal to register Applicant's mark under Trademark Act Section 2(d) is affirmed. In view thereof, we need not reach the refusal to register Applicant's mark under Trademark Act Sections 1, 2 and 45. *Cf. Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (the Board's determination of registrability does not require, in every instance, decision on every pleaded claim).